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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,092

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Bernhard Mussig

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27386

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02/05/2009

NORRIS, MCLAUGHLIN & MARCUS, P.A.

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EXAMINER

KOKKINOS, NICHOLAS C

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,092	<b>Applicant(s)</b> MUSSIG ET AL.	
	<b>Examiner</b> NICHOLAS KOKKINOS	<b>Art Unit</b> 4132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005 (Prelim. Amend.).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10 and 14, drawn to a winding film of polypropylene copolymer.

Group II, claim(s) 11-13, drawn to a process for producing a winding film.

4. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Evidence of lack of unity between the groups found in USPN 6,235,658 to Panzer et al. and USPA 2002/0019187 to Carroll et al.

5. Carroll et al. discloses a winding film of polypropylene copolymer (*copolymers of ethylene and propylene, page 8, paragraph [0061]*). Carroll et al. also claims films of polypropylene copolymer (*polyolefin polymer*) with an average thickness of less than 50 microns (*claim 2*), which overlaps Applicant's claimed range of 30-180 microns.

6. Carroll et al. discloses that the force at over 50% elongation should be at least 1.5 N/cm (*page 6, paragraph [0046]*), which overlaps the claimed force at 100% elongation of 2-20 N/cm.

7. Carroll et al. does not teach a crystallite melting point or the incorporation of flame retardant. Panzer et al. discloses polypropylene copolymer films (*column 1, lines*

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38-41) that have thicknesses of 3-200 micrometers along with flame retardant components of at least 40 phr (*column 2, lines 49-61*). Panzer et al. also discloses that the polypropylene homopolymers have a melt index, the same as the crystallite melting point, of 145-165 degrees C (*column 9, lines 13-17*).

8. Carroll et al. and Panzer et al. do not teach that the force at 1% elongation has a value of 0.6 to 4 N/m, but since the invention of Carroll et al. and Panzer et al. is identical in materials and structure to that of applicant's claim 1, and exhibits similar properties otherwise, it would be expected to possess a force at 1% elongation between 0.6 - 4 N/cm.

9. Carroll et al. teaches that it is preferable for garments to be strong, permeable to moisture, but impermeable to liquids (*page 1, paragraph [0001]*), and suggests melt extruding (*page 2, paragraph [0014]*) as a way of reducing the normally prohibitive costs (*page 1, paragraph [0007]*) of such garments. Panzer et al. teaches that their invention allows for even higher moisture permeability, yet is still waterproof, and utilizes the same extrusion coatings disclosed in Carroll et al. (*column 1, lines 4-12*).

10. It would not have constituted an inventive step to modify the teachings of Carroll et al. with those of Panzer et al., because both disclose the desirability of extrusion coated garments for reasons of lowered cost, improved moisture permeability, and improved waterproofness.

11. The above outlined structure of Carroll et al. in view of Panzer et al. teaches the entirety of instant claim 1. The subject matter of Claim 1 is the corresponding technical feature common among groups I and II. As such, the corresponding technical feature is

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not a corresponding special technical feature that defines a contribution over the prior art.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

14. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the

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above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

15. A telephone call was made to Kurt G. Briscoe on 5 December 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

16. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

17. The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

### CONCLUSION

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS KOKKINOS whose telephone number is (571)270-7384. The examiner can normally be reached on Monday-Thursday 9am-5pm.

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19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Lavilla can be reached on 571-272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NK/  
Nicholas Kokkinos  
Examiner, Art Unit 4132  
19 December 2008

**/Michael La Villa/  
Michael La Villa  
Supervisory Patent Examiner, Art  
Unit 4132  
2 February 2009**